

REMARKS

An Office Action was mailed in the instant case March 17, 2005, wherein Claims 1-18 as originally filed were rejected. Applicants submitted a response to this Office Action in the form of an amendment under 37 CFR 1.111 on August 15, 2005. In the Office Action dated August 25, 2005, Applicants' response of August 15, 2005 was held non-compliant for clerical errors. On September 13, 2005, Applicants' submitted a response to the Office Action mailed August 25, 2005 correcting the issues identified by the Examiner in the previous response. Examiner has now held the amendments made in the September 13, 2005 response to be non-responsive as being drawn to a non-elected invention.

For the Examiner's convenience, Applicants now provide remarks relating to the rejections to the originally rejected claims as alleged in the Office Action mailed March 17, 2005. Applicants respectfully request that the instant application be reconsidered in light of the request for continuing examination, the above amendments, and the following remarks.

Summary:

Claims 1-18 have been amended.

No claims have been canceled.

No New Claims have been added.

Claims 1-18 remain in the present application.

Applicants have amended Claim 1, and the claims that depend therefrom to further clarify that Applicants' presently claimed invention recites an expanded olefin resin particle, the particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Claim 15 has also been amended to further clarify a preferred embodiment of the presently claimed invention comprises spherical particles. Support for these amendments may be found in numbered paragraph [0074] of the application as filed. Previously independent Claims 16 and 17 have been amended to depend from independent Claim 1.

Double Patenting

In the Office Action dated March 17, 2005, Claims 1, 3-4, and 17 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 13 of U.S. Patent number 6,809,168 to Agarwal et al (hereinafter Agarwal-168.)

Claim 1, and the claims that depend therefrom, have been amended to further clarify that Applicants' presently claimed invention recites an expanded olefin resin particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Claim 13 of Agarwal-168 recites an article comprising a skin layer...wherein the skin layer is present on a film, fiber, fabric, molded article, and/or foamed article. Claim 13 does not recite nor suggest an expanded olefin resin particle and thus, Claim 13 of Agarwal-168 does not render Applicants' presently claimed invention obvious. As such, a rejection based on obviousness-type double patenting is inappropriate. In light of the amendments made to the claims, removal of the rejection is respectfully requested.

Claim Rejections Under 35 USC §102

In the Office Action dated March 17, 2005, Claims 1-13, and 15-18 were rejected under 35 USC §102 (e) as being anticipated by U.S. Patent number 6,809,168 to Agarwal et al (hereinafter Agarwal-168.)

In the Office Action dated March 17, 2005, Claims 1-11, 15, and 17 were rejected under 35 USC §102 (b) as being anticipated by U.S. Patent application US 2002/0013440 to Agarwal et al. (hereinafter Agarwal-440.)

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

The test for anticipation is symmetrical to the test for infringement and has been stated as: "[t]hat which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.@ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983).

Moreover, the single source must disclose all of the claimed elements arranged as in the claim. @ *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicants have amended Claims 1-18 as discussed above to further clarify that Applicants' presently claimed invention recites an expanded olefin resin particle, expanded with a blowing agent, and having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve.

However, Argarwal-168 and Argarwal-440 provide portions of identical disclosure directed to articles formed from propylene diene copolymers. At Col. 27, line 59 to Col. 29, line 26, Argarwal-168 discloses producing flat foamed sheets (Col. 28, line 30.) The portion of the disclosure of Argarwal-440 directed to foamed articles begins at numbered paragraph [0190], and is identical to the above referenced disclosure of Argarwal-168. Argarwal-440 is also identical to Argarwal-168 in that both references disclose producing flat foamed sheets (numbered paragraph [0192] of Argarwal-440), but fail to disclose or suggest the formation of Applicants recited expanded olefin resin particle.

Argarwal-168 and Argarwal-440 thus fail to disclose or suggest all of Applicants recited limitations. Accordingly, neither Argarwal-168 nor Argarwal-440 can reasonably be found to anticipate Applicants' presently claimed invention.

Claim Rejections Under 35 USC §103

In the Office Action dated March 17, 2005, Claims 1-11, 15, and 17 were rejected under §102 (b) as being anticipated by or, in the alternative, under §103(a) as being obvious over US 2002/0013440 to Agarwal et al. (hereinafter Agarwal-440.) Claims 10 and 11 have been rejected under §102 (e) as being anticipated by or, in the alternative, under §103(a) as being obvious over Agarwal-168.

As discussed above, neither Agarwal-168 nor Agarwal-440 can reasonably be found to anticipate Applicants' presently claimed invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of

obviousness. To do so, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Agarwal-440 is directed to propylene diene copolymers. In numbered paragraph [0086], Agarwal-440 discloses foamed articles to be another useful application of the disclosed copolymers. The disclosure of Agarwal-440 directed to foamed articles begins at numbered paragraph [0190], and is identical to the above referenced disclosure of Agarwal-168. Agarwal-440 is also identical to Agarwal-168 in that the reference discloses producing flat foamed sheets (numbered paragraph [0192]), but fails to disclose or suggest the formation of Applicants recited expanded olefin resin particle.

Applicants have amended Claims 1-18 as discussed above to further clarify that Applicants' presently claimed invention recites an expanded olefin resin particle expanded with a blowing agent, and having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Applicants also note in numbered paragraph [0009] of the instant application, expanded resin beads may demonstrate undesirable characteristics, which may be inconsistent with a materials use. Thus the ability to produce an expanded olefin resin particle does not automatically flow from the ability to produce a foamed article from a particular resin. Identical to Agarwal-168, Agarwal-440 discloses direct formation of a foamed sheet from an olefin resin and a blowing agent, however, the references fail to disclose or suggest discrete olefin resin particles or a process for making them. Agarwal-440 also fails to disclose or suggest expanded olefin resin particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. As such, Agarwal-440 does not disclose all of Applicants' recited limitations, nor provide a teaching or suggestion of success directed to expanded olefin

resin particles as recited by Applicants. Accordingly, Argarwal-440 cannot reasonably be found to render obvious Applicants' presently claimed invention.

In the Office Action dated March 17, 2005, Claims 12-14, 16 and 18 were rejected under §103(a) as being unpatentable over Agarwal-440 in combination with Polymer Technology Dictionary (hereinafter Dictionary.) Claim 14 has been rejected under §103(a) as being unpatentable over Agarwal-168 in combination with Dictionary.

Dictionary discloses certain blowing agents. Dictionary does not disclose, nor suggest Applicants recited expanded olefin resin particle having a particle size capable of passing through a number 2.5 Tyler mesh sieve, but which is retained on a number 30 Tyler mesh sieve. Dictionary thus fails to remedy the deficiencies in either Agarwal-168 or Agarwal-440. Accordingly, Claims 12-14, 16 and 18, as amended, are not rendered obvious by the combination of the cited references.

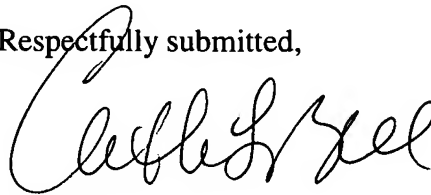
Applicants respectfully request the rejection of the claims be removed, and the claims be passed to allowance. Reconsideration and allowance is respectfully requested.

Attached is a Supplemental Information Disclosure Statement and Form 1449. If there are any additional charges with respect to the Amendment or otherwise, please charge them to Deposit Account No. 05-1612 maintained by Assignee.

1-5-2006

Date:

Respectfully submitted,



Catherine L. Bell
Registration No. 35,444
Attorney for Applicant

ExxonMobil Chemical Company
Law Technology Department
P.O. Box 2149
Baytown, Texas 77522-2149
Telephone No. 281/834-5982
Facsimile No. 281/834-2495